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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,672	07/26/2001	John M. Surwillo	070191/320 (31-CD-6181)	7286

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EXAMINER

OROPEZA, FRANCES P

ART UNIT PAPER NUMBER

3762

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/915,672

Applicant(s)

SURWILLO ET AL.

Examiner

Frances P. Oropeza

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 8/8/03 (Amendment).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 29-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election / Restriction***

1. Newly submitted claims 29-35 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Independent claims 29 and 32 comprise a stress test device and independent claim 29 further comprises a printing component. None of the original independent claims 1, 8, 15, 22, 24 and 27 comprise a stress test device or a printing component.

Since the Applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 29-35 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 103***

2. Claims 1, 3, 15, 16, 18-20 and 24-28 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Selker et al. (US 5501229) in view of Nakamura (US 6380921) for the reasons of record.

Selker et al. disclose an instrument for monitoring cardiac characteristics of a patient comprising an electrocardiograph (10), a printer (26), display (28) and keyboard (22) (figure 1; col. 2 @ 32-62). Selker et al. disclose the claimed invention except for an illuminating component (claims 1, 15 & 24), a component for activating and deactivating the illuminating component (claims 1, 8, 15, 22 & 24), a deactivating component

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(claims 1, 8, 12-15, 22, 24 & 28), illuminating the keypad (claims 3 & 19), the illuminating component being an LED (claim 16), a supporting element (claim 18), the computer program performing the illumination method (23), the predetermined time being 60 minutes (claim 23), an on/off switch (claims 25 & 27) and a light source (claim 26).

Nakamura discloses an illuminated touch screen and teaches using the following elements, combinable for the reasons noted, to modify the instrument for monitoring cardiac characteristics as taught by Selker et al.:

- an illuminating component (30) for the purpose of lighting the touch screen surface in order to enable the user to use the instrument in dark environments (col. 1 @ 15-20 and 32-36),
- a switch (6), read as a component for activating and deactivating the illuminating component, for the purpose of controlling the illumination source in order to provide light for the touch screen in order to enable the user to use the instrument in dark environments (col. 1 @ 15-20 and 32-36),
- the illumination controller (13), read as the deactivating component for the illumination component, and illumination timer (15) for the purpose of turning off the lights during periods when the touch screen has not be used for a predetermined period of time in order to save the power (col. 4 @ 13-18; col. 5 @ 53-60),
- illuminating the keypad/ touch screen (figure 1B) in order to enable the user to see clearly and use the instrument in dark environments

- (col. 1 @ 15-20 and 32-36),
- the illuminating component being an LED for the purpose of lighting the touch screen in order to enable the user to use the instrument in dark environments (col. 1 @ 15-20 and 32-36),
  - the lid, read as a supporting element, for the purpose of supporting and enabling direction of the lights to the touch screen (figure 1 B; col. 3 @ 44-46),
  - the CPU (11) and associated computer program controls the illumination method for the purpose of automating the control of the lights to optimize the handling performance of the instrument and to prevent wasteful power consumption (col. 4 @ 1-3 and 48-54),
  - the predetermined time being 60 minutes, for the purpose of providing sufficient time to review the results on the screen, yet not waste power or have the nuisance of having to re-illuminate the screen during the monitoring and data review process col. 4 @ 48-54). Absent any teaching of criticality or unexpected result for the specific time period, a 60 minute predetermined time period would have been an obvious design choice,
  - an on/off switch (6), read as a component for activating and deactivating the illuminating component, for the purpose of controlling the illumination source in order to provide light for the touch screen in order to enable the user to use the instrument in dark environments (col. 1 @ 15-20 and 32-36), and

- the illuminating component being a light source for the purpose of illuminating the touch screen in order to enable the user to use the instrument in dark environments (col. 1 @ 15-20 and 32-36).

The Applicant's arguments filed 8/8/03 have been fully considered but they are not convincing.

The Applicant asserts Selker et al. and Nakamura do not disclose the claimed invention because neither Selker et al. nor Nakamura address considerations underlying the claimed invention. The Examiner disagrees. The considerations underlying the claimed invention, as noted below, are not claimed hence they are not read into the claims.

In response to the Applicant's argument that the references fail to show certain features of the Applicant's invention, it is noted that the features upon which the Applicant relies (i.e., a medical instrument including extended period of non-use of the key pad, excessive power consumption, the type of power source (battery or wall socket)) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Selker et al. and Nakamura are deemed to disclose the claimed invention.

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3. Claims 2, 4 and 17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Selker et al. (US 5501229) in view of Nakamura (US 6380921) and further in view of Polley et al. (US 5868487) for the reasons of record. As discussed in paragraph 2 of this action, modified Selker et al. disclose the claimed invention except for illuminating a work surface (claims 2, 17 & 21) and the component for activating and deactivating being a toggle switch (claim 4).

Relative to illuminating work surface, Polley et al. teach computer work area lighting system using a light(s) on an arm to illuminate a work surface for the purpose of providing proper lighting for the work area. It would have been obvious to one having ordinary skill in the art at the time of the invention to have used lighting for the work surface in the modified Selker et al. system in order to enable the instrument operator to view and use the system components, including the work surface and printer, so the monitoring task is successfully completed (col. 1 @ 4-6, 16-25 and 49-53).

Relative to the toggle switch, Polley et al. teach computer work area lighting system using a toggle switch(es) (17, 18) for the purpose of activating and deactivating the illumination sources. It would have been obvious to one having ordinary skill in the art at the time of the invention to have used a toggle switch in the modified Selker et al. system in order to provide the instrument operator with control over the illumination system so the optimum lighting configuration can be controlled by the instrument operator (col. 1 @ 17-25; col. 2 @ 44-64; col. 3 @ 21-27; col. 4 @ 3-28).

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4. Claims 5-14, 22 and 23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Selker et al. (US 5501229) in view of Nakamura (US 6380921) and further in view of Nelms et al. (US 4365290) for the reasons of record. As discussed in paragraph 2 of this action, modified Selker et al. disclose the claimed invention except for the keys being associated with an instruction (claim 5), a determining component to scan the keyboard and determine if a key has been pressed (claims 6, 8, 11, 22), and deactivating the illuminating component when a toggle key is pressed (claim 9).

Relative to the keys being associated with an instruction, Nelms et al. teach a computer system using keys (26) associated with parameters, read as an instructions, for the purpose of enabling selected activity sequences for the instrument. It would have been obvious to one having ordinary skill in the art at the time of the invention to have used keys associated with an instruction in the modified Selker et al. system in order to effectively and efficiently accomplish multi-component tasks with the push of a single button (col. 4 @ 1-10; col. 10 @ 51-62).

Relative to a determining component to scanning the keyboard to determine if a key has been pressed, Nelms et al. teach a computer system using a decoder for the purpose of determining which keys have been pressed by the instrument operator. It would have been obvious to one having ordinary skill in the art at the time of the invention to have used a decoder in the modified Selker et al. system in order to provides the instrument with a component to enable communication between the operator and the computer system so the desired testing and monitoring is accomplished (col. 5 @ 55-65).



Relative the toggle key, Nelms et al. teach a computer system using a toggle key (22-2) for the purpose of activating and deactivating power. It would have been an obvious design choice to used a toggle key to activate and deactivate power to an illumination means. It would have been obvious to one having ordinary skill in the art at the time of the invention to have used a toggle key to activate and deactivate the illumination component in the modified Selker et al. system in order to have a convenient means for controlling the light associated with the instrument so the operator can effectively conducts the monitoring and evaluation of the patient (col. 8 @ 20-22).

5. Claim 21 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Selker et al. (US 5501229) in view of Nakamura (US 6380921) and further in view of Gallant et al. (US 4316249) for the reasons of record. As discussed in paragraph 2 of this action, Gallant et al. disclose the claimed invention except for the printing medium moving across the work surface.

Gallant et al. teach cardiac monitoring using a printer (14) where for the printing medium moves across the work surface for the purpose of enabling the instrument operator to continuously monitor the cardiac readings and make adjustments as needed. It would have been obvious to one having ordinary skill in the art at the time of the invention to have used a printer where for the printing medium moves across the work surface in the modified Selker et al. system in order to provide an optimum recording of the patient's cardiac activity so proper diagnosis and intervention can be undertaken if needed (figure 1; col. 5 @ 6-48).

***Specification***

6. The disclosure stands objected to because of the following informalities which the Applicant believed were addressed by the preliminary amendment of 1/18/02 were not addressed in the preliminary amendment of 1/18/02:

On page 6, line 8, it appears "plate 24" should be --plate 30--,

On page 7, line 10, it appears "plate 24" should be --plate 30--, and

On page 8, line 10, it appears "electrodes 16" should be --electrodes 14--.

Appropriate correction is required.

***Information Disclosure Statement***

7. The copy of one reference, "Office Action of Application No. 09/915671", listed in the information disclosure statement filed 8/8/03 was not included with the submission and accordingly has not been considered. This portion of the information disclosure statement fails to comply with 37 CFR 1.98(a)(2) which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. The "Office Action of Application No. 09/915671" reference has been lined through and all other references reviewed and initialed on the information disclosure statement. The information disclosure statement has been placed in the application file.

***Statutory Basis***

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

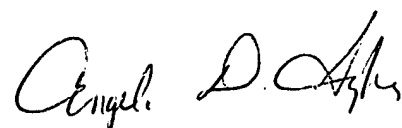
Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Fran Oropeza, telephone number is (703) 605-4355. The Examiner can normally be reached on Monday – Thursday from 6 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Angela D. Sykes can be reached on (703) 308-5181. The fax phone number for the organization where this application or proceeding is assigned is (703) 306-4520 for regular communication and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist, telephone number is (703) 308-0858.

Frances P. Oropeza  
Patent Examiner  
Art Unit 3762

380  
10/2/03



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